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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,043	06/26/2001	Dale F. McIntyre	83013F-P	1730

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EXAMINER

FLEURANTIN, JEAN B

ART UNIT

PAPER NUMBER

2172

DATE MAILED: 05/06/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary

Application No.

09/892,043

Applicant(s)

MCINTYRE, DALE F.

Examiner

Jean B Fleurantin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 25 March 2004 RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 25, 2004 has been entered, in which claims 1-24 remain pending for examination.

Remarks

2. Applicant's arguments, see Paper No. 11, filed 25 March 2004, with respect to the rejection(s) of claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over US Patent 6,321,231 issued to Jebens (hereinafter "Jebens") have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new grounds of rejection is made in view of U.S. Patent No. 5,737,491 issued to Allen et al. (hereinafter "Allen"), and further in view of US Patent 6,523,046 issued to Liu et al. (hereinafter "Liu").

MPEP 2111 Claim Interpretation; Broadest Reasonable Interpretation

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162

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USPQ 541,550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim. See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in application’s specification.”).

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 12-20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,321,231 issued to Jebens et al. (“hereinafter Jebens”) in view of US Patent No. 5,737,491 issued to Allen et al. (hereinafter “Allen”).

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As per claims 1, 12 and 24, Jebens discloses, “a method for providing an automatic service over a communication network to a user based on stored instructions by a user on a user computer” as a means for receiving instructions from the first user directing that the electronic file be delivered to a second user, and automatically routing the electronic file (see col. 3, lines 5-10), comprising the steps of:

“automatically initiating the obtaining of instructions stored on a user computer over said communication network by a service provider” as a means for receiving instructions from the first user directing that the electronic file be delivered to a second user, and automatically routing the electronic file, (see col. 3, lines 5-10), and further, in column 18, line 63 to column 19, line 10, Jebens discloses the hot-folder system automatically moves the files to a processing queue and then compresses the file per predetermined compression settings, in which the communication portion of the local computer then establishes a connection with the host site. Jebens does not explicitly disclose said instructions being associated with a digital media file stored on said user computer; and implementing said instructions with respect to said associated digital image file. However, Allen discloses a memory for storing digital images produced by the image sensor in digital image files, the digital image files having associated information for controlling a remote image fulfillment server, (see Allen col. 1, lines 36-45). It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the combined teachings of Jebens and Allen with said instructions being associated with a digital media file stored on said user computer; and implementing said instructions with respect to said associated digital image file. Such modification would allow the teachings of Jebens and Allen to improve the accuracy and the reliability of the method and system for managing images over a

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communication network using user provider instructions, and to provide a choice of different communication relay services, (see col. 1, lines 59-60).

As per claims 2 and 14, Jebens discloses, “where said instruction comprises instructions relating the sale of rights to use and/or reproduce said image”, (see col. 9, lines 47-51).

As per claims 3 and 15, Jebens discloses, “where said instruction comprises the purchase, use, or sale of an item displayed in said image” as invoices are developed by reference to the activities logged in the activity log during a pre-defined billing period, predefined ones of the events are assigned a charge by the system, all of the charges for a given image provider user are preferably automatically organized and displayed in an invoice, (see col. 17, lines 43-51).

As per claims 4 and 16, Jebens discloses, “wherein said instruction was entered on a form, (see col. , 17, lines 43-46).

As per claims 5 and 17, Jebens discloses, “wherein said form is displayed in association with said image”, (see col. 20, line 60 to col. 21, line 6).

As per claims 6 and 18, the limitations of claims 6 and 18 are rejected in the analysis of claim 1, and these claims are rejected on that basis.

As per claims 7 and 19, Jebens discloses, “wherein the service provider recognizes that a digital image file has been identified for a service during a routine communication interval” as the low-resolution images downloaded to the agency preferably have a relatively low bandwidth communication requirement and can be transmitted in a relatively short amount of time, (see col. 5, lines 24-35).

As per claims 8 and 20, Jebens discloses, “wherein an electronic form is provided to the user by service provider in response to discovering of the identified digital image file” as displays the status of any recently place work orders, (see figure 10F col. 21, lines 46-53).

As per claim 13, in addition to claim 1, Jebens further discloses “said associated digital image file representing an image” as a means for translating the digital images received by the system into a file format defined by the first asset provider user before storing the digital images in the storage device, (see col. 27, lines 44-47).

4. Claims 9-11 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,321,231 issued to Jebens et al. (“hereinafter Jebens”) in view of US Patent No. 5,737,491 issued to Allen et al. (hereinafter “Allen”) as applied to claims 2 and 14 above, and further in view of US Patent 6,523,046 issued to Liu et al. (hereinafter “Liu”).

As per claims 9-11 and 21-23, Jebens and Allen disclose the claimed subject mater except the claimed a metadata field of the identified digital image file is modified to reflect the

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data added to the electronic form; wherein the metadata field is provided in said service provider computer; wherein the metadata field is provided in said user computer. However, Liu discloses various types of data referenced by the pointer value stored in the value field for a particular metadata property item, (see Liu col. 9, line 16 to col. 10, line 44). It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the combined teachings of Jebens, Allen and Liu with a metadata field of the identified digital image file. Such modification would allow the teachings of Jebens, Allen and Liu to provide applications that seek to read metadata associated with the multimedia files, (see Liu col. 2, lines 56-57).

Prior Art

5. The art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,011,758 issued to Dockes et al.

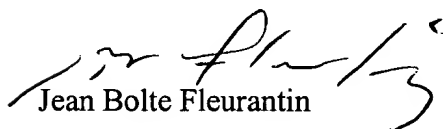
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CONTACT INFORMATION


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean B Fleurantin whose telephone number is 703-308-6718. The examiner can normally be reached on 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John B Breene can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jean Bolte Fleurantin

April 28, 2004


SHAHID ALAM
PRIMARY EXAMINER